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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAVEL NOVAK

Appeal 2009-010849
Application 10/601,406
Technology Center 2400

Decided: June 21, 2010

Before JAMES D. THOMAS, MAHSHID D. SAADAT,
and CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.
THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 8, 10 through 29, 31 through 50, 52 through 71, and 73 through 82. Appellant has canceled claims 9, 30, 51, and 72. We

have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was conducted on this appeal on June 10, 2010.

We reverse.

INVENTION

A system for controlling medical devices is disclosed, generally comprising a surgical network, an input device for entering a medical command, a controller for generating medical command data, and a translator for communicating with at least one ancillary device, where the ancillary device is either a device that is not compatible with the surgical network or is a device that generates high-bandwidth data. In some embodiments, the ancillary device is connected via Ethernet for high-bandwidth data transmission or via Bluetooth for wireless control.

(Abstract, page 16 of the Spec., Figure 1.)

REPRESENTATIVE CLAIM

1. A system which controls ancillary medical devices, comprising:

a surgical network;

an input device, connected to said surgical network, which inputs a medical command;

a controller, connected to said surgical network, which receives the medical command and generates corresponding medical command data;

a translator, connected to said surgical network, which receives the

medical command data via said surgical network and translates the medical command data;

at least one ancillary medical device, in communication with said translator via an ancillary network, which receives the translated medical command data and carries out the corresponding medical command; and

a data stream, generated by at least one of said at least one ancillary medical devices and communicated to said translator via said ancillary network, with a higher bandwidth than said surgical network is capable of transmitting.

PRIOR ART AND EXAMINER'S REJECTIONS

The Examiner relies on the following references as evidence of unpatentability:

| | | |
|----------|-----------------|--|
| Bauer | US 5,788,688 | Aug. 4, 1998 |
| Igarashi | US 6,067,571 | May 23, 2000 |
| Flach | US 6,589,170 B1 | Jul. 08, 2003 (filed May 25, 2000) |
| Suzuki | US 7,103,646 B1 | Sep. 05, 2006 (filed Aug. 09, 1999) |

All claims on appeal stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 1, 2, 10 through 12, 18 through 23, 31 through 33, 39 through 44, 52 through 54, 60 through 65, 73 through 75, 81, and 82, the Examiner relies on Bauer in view of "what is well known in the art." This initial rejection includes independent claims 1, 22, 40, 41, 42, 43, 64, and 82. The second stated rejection is directed to claims 3, 4, 8, 13, 14, 17, 24, 25, 29, 34, 35, 38, 45, 46, 50, 55, 56, 59, 66, 67, 71, 76, 77, and 80 as

being obvious over Bauer in view of "what is well known in the art," further in view of Flach. The third stated rejection of the Examiner appears to rely upon the same latter combination of references to reject claims 5, 15, 26, 36, 47, 57, 68, and 78. Lastly, in a fourth stated rejection as to claims 6, 7, 16, 27, 28, 37, 48, 49, 58, 69, 70, and 79, the Examiner relies upon Bauer in view of "what is well known in the art," further in view of Suzuki.

CLAIM GROUPINGS

Based upon Appellant's arguments in the Appeal Brief, Appellant argues common features among independent claims 1, 22, 40, 41, 42, 43, 64, and 82. No arguments are presented as to any dependent claim in any of the four stated rejections. We consider independent claim 1 as representative.

ISSUE

Did the Examiner err in finding that the combination of Bauer and "what is well known in the art" would have rendered obvious to a person of ordinary skill in the art the subject matter of representative independent claim 1 on appeal?

ANALYSIS

Since we find that the Examiner has failed to establish a *prima facie* case of obviousness within 35 U.S.C. § 103, we reverse the rejection of representative independent claim 1 on appeal.

Since we agree with Appellant's overview assessment of the teachings in Bauer as expressed at pages 11 through 13 of the principal Brief, and because we consider this assessment to be consistent with the Examiner's views (and our study of it as well) as to this reference in formulating the first stated rejection, we reproduce them here:

The present invention relates to a system for simultaneously controlling primary medical devices, which are connected to a surgical network, and ancillary devices, which are not compatible with the surgical network, or at least transmit some data which can not be carried by the surgical network. Traditional systems, such as the one disclosed in Bauer, for controlling both primary medical devices and ancillary devices have relied upon two completely separate networks for controlling these two different types of devices. Thus, for example, Bauer includes a first network (i.e., a surgical network) comprising an IEEE-488 or RS-485 card (designated as 76 in Figure 3) with which devices 44, 46 are in communication, and a second network (i.e., an ancillary network or video network) comprising a frame store card (designated as 90 in Figure 3) with which VGA monitor 68, video fail-safe switch 94, camera control unit 49 and endoscopic camera 74 are in communication. More specifically, all communications with components of the first network 76, 44, 46 take place via the first network (i.e., no communications concerning any of these components is communicated over the second network), and all communications with components of the second network 90, 68, 94, 49, 74 take place via the second network (i.e., no communications concerning any of these components is communicated over the first network).

More specifically, all independent claims recite both a surgical network and an ancillary network. All independent claims also recite that at least one medical device is in communication, at least indirectly, with both networks and that medical command data for

controlling the medical device be communicated over the surgical network, and also that a data stream or feedback data generated by the medical device be communicated over the ancillary network.

Appellant respectfully submits that Bauer does not disclose, teach or suggest these limitations.

(Brief, pages 11, 12, and 13).

Pages 13 and 14 of the principal Brief further consider the teachings of Bauer from the perspective of one of ordinary skill in the art as applied to different, optional limitations of the claims on appeal. Even though we recognize that Appellant's positions in all of these noted pages from the principal Brief are couched in the context of Bauer anticipating the claims on appeal, the teachings themselves are still pertinent for our consideration and those of a person of ordinary skill in the art within 35 U.S.C. § 103.

With this understanding of Bauer and the corresponding requirements reflected among the independent claims on appeal, we find that the Examiner's initial stated rejection encompassing all independent claims on appeal must be reversed since the Examiner's broad statement of "what is well known in the art" as a modifying teaching is without evidentiary value. It amounts merely to a brute force argument of obviousness without any additional evidence supporting the assertions made by the Examiner. The Examiner's view as to "what is well known in the art" is presumptuous and without a factual basis. Couching this reasoning of the Examiner in the context of Official Notice also is of no help to the Examiner's weakly based position.

Even if we were to consider the Examiner's assertion as to what was well known in the art at the time of the present invention was a technical fact of common knowledge in the art, the Examiner's views presume that it would then have been obvious for a person of ordinary skill in the art to have modified the teachings of Bauer within 35 U.S.C. § 103 in light of this alleged fact. We take a similar view with respect to the Examiner's subsequent brief reliance upon Igarashi at page 20 of the Answer. The Examiner's reliance upon this reference at this late stage of the prosecution would appear to be the formulation of a new ground of rejection in the Answer that has not been properly approved. Even if it were, we are in general agreement with Appellant's remarks as to this reference beginning at the bottom of page 4 of the Reply Brief. Igarashi appears to teach that his devices are only connected to one network rather than to the required two separately stated networks in each independent claim on appeal.

CONCLUSION AND DECISION

Appellant has shown that the Examiner erred by failing to establish a *prima facie* case of obviousness of representative independent claim 1 on appeal based upon Bauer in view of "what is well known in the art." Therefore, we must reverse the rejection of this representative claim and the remaining independent claims on appeal, as well as the rejections of all

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dependent claims encompassed by the four stated rejections under 35 U.S.C. § 103. The Examiner is reversed.

REVERSED

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